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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,110

10/26/2005

Lynne Canne Bannen

EX03-039C-US

3309

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7590

12/23/2008

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EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,110	Applicant(s) BANNEN ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 42-60 is/are pending in the application.
- 4a) Of the above claim(s) 43-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-13, 15, 16 and 29 to 33 and 42 is/are rejected.
- 7) ☒ Claim(s) 4-6, 14, 17-28 and 34-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/21/05, 12/17/07, 12/27/07, 12/9/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Receipt is acknowledged of the information disclosure statements filed March 21, 2005, December 17, 2007, December 27, 2007 and December 9, 2008, which have been entered in the file.

Applicant's election with traverse of Group I, claims 1 to 42, in the reply filed on November 21, 2008 is acknowledged. The traversal is on the ground(s) that each of Groups I-IV possess unity of invention because all include a common, special technical feature which is $S(O)_2$ -W-O-W. This is not found persuasive because the special technical feature $S(O)_2$ -W-O-W is known in the prior art. Note U.S. Patent 5,753,653, for example.

The requirement is still deemed proper and is therefore made FINAL.

Claims 43 to 60 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 21, 2008.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 3, 6 to 13, 15, 16 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Zook et al. (US 5753653), cited by applicants.

The reference discloses the claimed compounds and pharmaceutical compositions of the formula I and IV wherein R^2 is $R^{21}-L^2-R^{22}$ where R^{21} is phenyl; L^2 is O; R^{22} is optionally substituted phenyl; L^1 is $-C(O)$ or SO_2 ; and R^1 is $NR^{12}R^{13}$, $-C(O)R^{11}$ or $-(CH_2)_nR^{11}$. Note the compounds of the formula I-a in column 4 where X is $N-R_3$ and W is CH_2 and Examples 1 to 9, for example.

Claims 1 to 3, 7 to 12, 15, 16, 29 to 33 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Neya et al. (US 6333324), cited by applicants.

The reference discloses the claimed compounds and pharmaceutical compositions of the formula I and IV wherein R^2 is $R^{21}-L^2-R^{22}$ where R^{21} is phenyl or thienyl; L^2 is O or a direct bond; R^{22} is optionally substituted phenyl; L^1 is $-C(O)-$ or SO_2 ; and R^1 is $NR^{12}R^{13}$, $-C(O)R^{11}$ or $-(CH_2)_nR^{11}$. Note Examples 19 and 55, for example.

Claims 4 to 6, 14, 17 to 28 and 34 to 40 are objected to as being dependent upon a rejected base claim, but would be

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allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art or disclose compound similar to those in the references relied upon.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art Unit
1626

ftp
December 21, 2008